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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,433	10/17/2005	Wassyl Nowicky	P/4637-11	6431
2352 7590 07/15/2009 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER				
AULAKH, CHARANJIT				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
07/15/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/549,433

Applicant(s)

NOWICKY, WASSYL

Examiner

Charanjit S. Aulakh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26, 28-32, 35-43, 45-49, 51, 52, 54, 55, 57 and 61 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 26, 28-32, 35-43, 45-49, 51, 52, 54, 55, 57 and 61 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-949)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. According to paper filed on July 1, 2009, the applicants have filed a RCE; canceled claims 59 and 62 and furthermore, have amended claims 26, 29, 30, 40, 42, 43, 45, 48, 49, 52, 54, 55, 57 and 61.
2. Claims 26, 28-32, 35-43, 45-49, 51, 52, 54, 55, 57 and 61 are pending in the application.

Response to Arguments

3. Applicant's arguments filed on July 1, 2009 have been fully considered but they are not persuasive regarding enablement rejection of claims 57 and 61. The examiner does not agree with the applicants arguments that results are presented in examples 5, 7-13, 19, 22 and 23. There are no results present in these examples. If applicants do have these results, they must present in an affidavit form showing efficacy of instant compounds on specific cancer cell lines, osteoporosis and radiation damage. The applicants have amended claims to overcome all other rejections.

Conclusion

4. Rejection of claims 57 and 61 under 35 U.S.C. 112, first paragraph is maintained for the reasons of record.

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 26, 28-32, 35-43, 45-49, 51 and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 26 and 43, the value of variable R1 in formula (I) is not defined.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 43, 45-49, 51 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Zbierska (Herba Polonica).

Zbierska discloses anticancer properties of N-methylchelidonine (see summary on page 315). The compound disclosed in figure 1 (see page 313) and its anticancer activity (see tables 2 and 3 on page 313) disclosed by Zbierska anticipates the instant claims when variable R1 represents methyl group in the instant compounds of formula (I). It is of note that the instant claims 43, 45-49, 51 and 57 are directed to a product by a process and therefore, the process is irrelevant unless applicants provide proof that the product by this process is different from the product disclosed by the cited reference.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 52, 54, 55 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zbierska (Herba Polonica).

Zbierska discloses anticancer properties of N-methylchelidonine (see summary on page 315). The compound disclosed in figure 1 (see page 313) and its anticancer activity (see tables 2 and 3 on page 313) disclosed by Zbierska meets all the limitations of the instant claims except that variable R1 represents methyl group instead of instant H or ethyl group. However, the compound disclosed by Zbeirski is a structural homolog of instant compounds and the structural homologs are well known in the art to share same properties. Therefore, it would have been obvious to one skilled in the art to prepare the instant structural homolog compounds without affecting their utility of anticancer activity with reasonable expectation of success.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is

(571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on (571)272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charanjit S. Aulakh/
Primary Examiner, Art Unit 1625